

REMARKS

Claims 1-27 are pending in the application. All claims stand rejected under 35 USC §102(e) over Sheridan.

Generally, the claims are drawn to an email client that has an authoring component which is capable of authoring in different modes. Each mode causes the email to appear differently when it is read. Sheridan is concerned with an online system in which users share access to digital photos. A feature of Sheridan is that after users upload photos to a server, email can be automatically sent to the user's friends inviting them to visit the site where the photos are stored. The uploader can assign different permissions to friends, i.e. can grant permission to view only or to view and print, etc. The Examiner apparently sees these permissions to be like the claimed authoring modes. In order to make the analogy work, one must ignore the plain meaning of the word "email", must confuse a web page with an email message, and must ignore that causing a difference in the appearance of something that is not authored is clearly not the same as causing a difference in the appearance of what is authored. Assigning permissions in Sheridan is not authoring an email and the email that is generated looks the same regardless of the permissions selected.

Regarding claims 2 and 9, the Examiner simply states that Sheridan discloses these features "as inherent feature of users". Sheridan does not disclose or suggest the features of claims 2 and 9 and it appears that the Examiner is relying on the principle of

official notice without saying so. If this is the case, the Applicant is entitled to demand that the Examiner cite a teaching reference.

Regarding claims 3 and 10, the Examiner cites col. 7 of Sheridan which describes how a digital photo is identified and confuses this with encoding the mode of an email message.

Claims 4 and 24 are rejected as “inherent feature of internet email encoding”. While MIME types are known, they are not used to identify an authoring mode as claimed herein. It appears that the Examiner is misinterpreting the plain language of the claims to mean whatever he wants and is not even consistent. In addition, claim 24 depends from claim 22 which at this point in the office action has not yet been addressed by the Examiner.

Claims 5 and 11 concern different tools for responding to an email message depending on the mode the original message was authored in. Here the Examiner cites cols. 4 and 5 of Sheridan. Here the Examiner seems to be equating the permissions in Sheridan with the tools used to respond to an email message which is nonsensical unless you ignore the plain meaning of “respond to the message.”

Claims 7 and 13 concern how information is organized in an email message depending on the mode in which it was authored. The Examiner addresses these claims as

“inherent feature of access rights.” Here the Examiner again ignores the plain language of the claims, confuses email and web pages, and confuses access with “organization”.

Claim 8 is rejected as being similar to claim 1. Claim 8 sets forth different and additional features than claim 1 and the Examiner has not addressed them.

Independent claim 14 provides “at least one of said authoring/reading components is responsive to a role mode encoded in an email message whereby said role mode determines how information in said email message will be displayed.” Here again the Examiner refers to col. 7 of Sheridan which relates to how digital image files are to be named. This rejection bears no relation whatsoever to the claim language and cannot properly be sustained.

Claims 15-18 are rejected as being similar to claims 2 and 5-7. The remarks made above regarding claims 2 and 5-7 thus apply to this rejection as well.

The rejection of independent claim 19 refers to an unidentified reference named “Hawana” and states that a web browser anticipates claim 19. This ignores the plain meaning of software “components” and “application programming interface.” Moreover, it is inappropriate to combine secondary references in a rejection under §102.

Claim 20 depends from claim 19 and specifies more about the API. Other than repeating what claim 20 says, the Examiner's entire rejection is "Sheridan, WWW, Fig.1". Claim 21 is rejected with the same cryptic phrase.

Independent claim 22 is rejected as being similar to claim 14, but claim 22 is a method and claim 14 is an apparatus.

Claim 23 is rejected simply as inherent in access rights but the Examiner has provided no evidence that it is.

Claim 25 provides "the role mode determines what tools may be used by the email client to view the representation of information." The Examiner suggests that this is inherent in access rights but provides no evidence that it is. The "permissions" in Sheridan are "view, print, copy and email". There is no mention of what tools are used to view anything or that different tools would be used to view the same information in different ways.

Claim 26 is similar to claim 25 but specifies what tools may be used to respond to the email. The Examiner states that this is inherent in access rights, but provides no evidence. Moreover, Sheridan never discusses responding to an email message.

Claim 27 specifies "the role mode determines how much of the representation of information can be viewed by the email client." The Examiner states that this is inherent

in access rights, but provides no evidence. Moreover, the permissions in Sheridan seem to provide all or nothing right to view a photo album, not how much of an email message can be viewed.

Claims 1-27 also stand rejected under 35 U.S.C. §103 as obvious over Madsen in view of King. Madsen discloses an email system. King discloses a method for inline variable management in a hypermedia display language. In one email example, King shows how programming tasks can be divided into subroutines called “activities”. The Examiner views these activities as equivalent to the authoring modes of claim 1. The Examiner’s stated motivation to combine King with Madsen is “to improve the email apparatus.”

King shows that an email program may include two main activities: create new message and view message. View message may include a delete function and a forward function. None of the activities operate in different modes which cause a message to be displayed in a different way depending on the mode in which it was authored. Moreover, the stated incentive is clearly faulty. The incentive to combine must be found in the art not made up by the Examiner. The Examiner’s stated incentive could be used to combine any two references if the combination would result in some “improvement”.

Claim 2 is again rejected as inherent but the Examiner has not provided any evidence that it is.

Claim 3 further specifies that the mode of the message is encoded in the message. Here the Examiner cites a portion of Madsen which states that an email message can be encrypted. The Examiner seems to be focused on the letters ENC as being the main point of claim 3 and never really gets to what the real point is, i.e. that the mode of the message is encoded in the message.

With regard to claim 4, the cited portion of Madsen does not mention MIME-type.

Claim 5 provides different sets of tools for responding to an email depending on the mode it was authored in. The Examiner cites a portion of King which describes how a shell program prevents a user from getting access to certain system resources. But the stated rejection mentions “create new message...view message...”. It is impossible to determine how the Examiner is interpreting claim 5.

Claim 6 specifies that the authoring mode determines whether the email recipient will be able to read all of the email content or only a subset of the content. The Examiner refers to the same section of King and makes the same remarks as in the rejection of claim 5. It is impossible to determine how the Examiner is interpreting claim 6.

Claim 7 specifies that the information in the email is organized in a different way depending on the authoring mode. The Examiner refers to the same section of King and

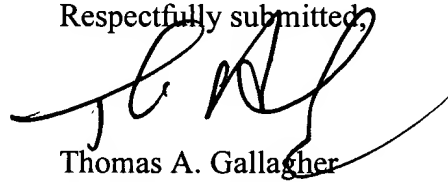
makes the same remarks as in the rejection of claim 5. It is impossible to determine how the Examiner is interpreting claim 7.

Sweepingly, the Examiner rejects claims 8-27 for having “similar limitations set forth of method claims 1-7”. Not only are claims 1-7 apparatus claims, there is no way the Applicant can understand the basis of this rejection.

The Applicant has attempted to understand the grounds for rejection and has attempted to reply to it as best it could be understand. It is believed that the Examiner is taking an interpretation of the claims that is contrary to their plain meaning. The Examiner did not set forth a proper argument for anticipation of the claims and failed to present a prima facie case for obviousness. Indeed, many claims were simply not addressed in a meaningful way.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. A. Gallagher', written over the typed name.

Thomas A. Gallagher
Reg. No. 31,358
Attorney for Applicant(s)

GORDON & JACOBSON, P.C.
60 Long Ridge Road
Suite 407
Stamford, CT 06902
Tel: (203) 323-1800
Fax: (203) 323-1803

September 19, 2005